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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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31M1/0628

MORANO EXAMINER	
ART UNIT	PAPER NUMBER
3103	2

DATE MAILED:

06/28/95

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/304,831

Applicant(s)
Houston

Examiner
S. Joseph Morano

Group Art Unit
3103



☒ This application has been examined. ☐ Responsive to communication filed on _____.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the date mailed of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Status of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Status of Drawings

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

Status of Specification

☐ The specification is objected to by the Examiner.

Status of Oath or Declaration

☐ The oath or declaration is objected to by the Examiner.

Status of Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in application no. (series code/serial number) _____.

☐ received by the International Bureau in PCT application no. _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892 ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413 ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Other

☐

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Correction of the following minor informalities is suggested so as to improve the readability of the application:

1) On line 5 of the abstract, --made of-- should be inserted before "strips".

2) On line 10 of page 6, --the-- should be inserted before "liner".

3) On line 12 of page 6, --,-- should be inserted after "variations", and --a-- should be inserted before "novel".

4) On line 1 of page 14, --it-- should be deleted.

5) On line 3 of page 18, --,- should be inserted after "section".

6) On line 4 of page 18, "," after "56" should be deleted.

7) On line 24 of page 19, --,-- should be inserted after "comparison", and "," after "liners" should be deleted.

8) On line 1 of page 20, "A" should read --In a--.

9) On line 3 of claim 6, --,-- should be inserted before "with", and "," after "surface" should be deleted.

2. Correction of the following formalities is required:

1) On lines 19 and 26 of page 18, "58" should read --59-- so as to correspond with the element in the drawings.

2) On line 13 of claim 1, "track" should read --truck--.

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3. Applicant is advised that US patent no. 4,094,235, which was discussed in the specification as relating to a wear plate, contains subject matter which is completely unrelated to the present invention, and is not a wear plate. It is believed that this patent number may contain a typographical error, and if so, applicant is requested to amend the specification to recite the proper number.

4. The drawings are objected to because element number 36 is discussed in the specification, yet does not appear in the figures. Correction is required.

5. Applicant is required to submit a proposed drawing correction in response to this Office action. However, correction of the noted defect can be deferred until the application is allowed by the examiner.

6. Claim 8 is objected to as being in improper format, since it is not in single sentence form.

Specifically, claim 8 is missing a period at the end of the claim.

7. Claims 4 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, on line 3 of claim 4, "said parts" lacks proper antecedent basis. Claim 8 is confusing as a whole, as applicant has already claimed "an inner wrench surface", "an outer wrench surface", and "a break off head" in relation to the "one" cap, yet is now re-reciting these elements in relation to both caps, generating confusion in the claim. It is suggested that: replacing "an" (both occurrences) on line 2 of claim 8 with --a said---, replacing "surface" (second occurrence) on line 3 of claim 8 with --surfaces--, inserting --said-- after "a" on line 4 of claim 8, replacing "surface" (both occurrences) on line 7 of claim 8 with --surfaces--, and replacing "cap" on line 8 of claim 8 with --caps--, would correct this problem.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

10. Claims 1-2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Houston.

The Houston reference shows a two-part pedestal liner for a locomotive truck, having a U-shaped channel construction of nylon (figure 2), and a polyurethane insert 9 of higher resiliency. The liner also has attachment means for attaching the liner to the pedestal legs, this attachment means comprising bolts 46, and spacers 14-15, 44-45. The holes 43 in the spacers are sized to be greater than the diameter of the fastening elements, thereby allowing movement or articulation of the liner at its attachment point (column 3, line 66, to column 4, line 1). As described,

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the Houston reference shows all of the features of the indicated claims as so broadly stated at present.

11. Claims 3-4 are rejected under 35 U.S.C. § 103 as being unpatentable over Houston in view of Cummins.

The Houston reference, as described above, shows all of the features claimed except for the use of multiple inserts for the liner, and a dowel in hole connection system for the inserts. The Cummins reference shows the use of multiple inserts with a dowel connection system to be well known in the art for use on pedestal liners which utilize inserts, in order to allow the installer to quickly and efficiently install inserts of varying thickness for the liner, so as to accommodate diverse wearing patterns on the pedestals for different trucks. It would have been obvious to one of ordinary skill in the art at the time of the invention, to modify Houston to include the use of multiple inserts and dowel fasteners, as taught by Cummins, in order to allow the installer to quickly and efficiently install inserts of varying thickness for the liner, so as to accommodate diverse wearing patterns on the pedestals for different trucks.

12. Claims 5-6 are rejected under 35 U.S.C. § 103 as being unpatentable over Houston in view of Cole et al.

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The Houston reference, as described above, shows all of the features claimed except for the use of a bolted connection where at least one of the caps has an outer break-off head of greater diameter than a diameter of an inner head. The Cole reference shows the use of using an outer break-off head of greater diameter than a diameter of an inner head, to be well known in the art for use on threaded fastenings, in order to ensure proper torquing of the connection. It would have been obvious to one of ordinary skill in the art at the time of the invention, to modify Houston to include the use of at least one of the caps having an outer break-off head of greater diameter than a diameter of an inner head, as taught by Cole, in order to ensure proper torquing of the connection, thereby preventing possible damaging to the liner or pedestal due to over-torquing of the connection.

Applicant should note that while the Houston reference does not explicitly discuss or show a removable cap (nut), the use of a nut is expressly implied to one possessing ordinary skill in the art, as by its most common definition a bolted connection comprises a bolt and a nut, and as the inserts of Houston are explicitly disclosed as being non-threaded, if there were no nut on the other end of the bolts 46, the threaded end of the bolt would hang out in mere space and would not be able to connect the liner to the pedestal legs. Therefore, the Houston reference is

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considered to show a nut as well as a bolt to one possessing ordinary skill in the art.

In the alternative; however, it would have been obvious to one of ordinary skill in the art at the time of the invention, to include the use of a nut along with the bolt as the specific mechanical fastening means for attaching the liner to the pedestal legs, as the use of nuts with bolts is prolific in use throughout the mechanical arts, and use of a nut with the bolt would have been considered an obvious expedient to the ordinary worker in the art, depending on the cost, availability, and assembly/disassembly requirements for the device for a particular application at hand.

13. Claims 7-8 are rejected under 35 U.S.C. § 103 as being unpatentable over Cole et al in view of DT patent no. 2011739 (DT'739).

The Cole reference shows all of the features claimed, except for the use of its advantageous break-away driving head in a bolt and nut fastening application. The Cole reference shows the use of its advantageous threaded fastening in a bolt in threaded clip application. The DT'739 reference shows the use of bolt and nut connections, to be a well known and suitable type of alternate equivalent application in the art for the advantageous break-away driving head of Cole. It would have been obvious to one of

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ordinary skill in the art at the time of the invention, to modify Cole to expand the use of its advantageous break-away driving head to bolt and nut applications, as taught by DT'739, as this would have been considered an obvious alternative application and use for the break-away driving head of Cole, in a related field of endeavor, in order to increase the economic viability and marketability of the invention of Cole.

Regarding claim 8 and the use of the break-away driving head on both the nut and the bolt, it would have been obvious to one of ordinary skill in the art at the time of the invention, to modify the combination to include the use of the break-away driving head on both the bolt and the nut, as this would have been considered an obvious duplication of parts to the ordinarily skilled worker in the art, as the duplication/reduction of identical parts which perform essentially the same function is a common occurrence throughout the mechanical arts, and the specific use of a second break-away driving head would have been an obvious matter of design preference, depending upon such common factors as the additional material and construction costs for a second head, versus the additional ease of assembly that such a dual break-away driving head would provide by allowing the fastening to be properly torqued from either side of the connection, the ordinary worker choosing the best number of heads

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which would most optimize the cost and performance of the device for a particular application at hand, based upon these factors.

14. Ditzler et al, Kleykamp, and Kirilloff et al, are all cited as examples in the art of pedestal wear liners, while FR patent no. 1490954 is cited as an example in the art of a dual head bolt and nut fastening.

15. Any inquiry concerning this communication should be directed to S. Joseph Morano at telephone number (703) 308-0230. Examiner Morano can normally be reached Monday through Thursday, 6:30am-5:00pm.

sjm
June 11, 1995



**S. JOSEPH MORANO
PATENT EXAMINER
GROUP 310**